

Appl. No. : 10/647,801  
Amendment dated June 2, 2005  
Responsive to Office Action dated December 2, 2004

### Remarks

Claims 1-5, 10, 12-16, 18-22 and 29-71 are pending. Claims 6-9, 11, 17 and 23-28 have been canceled. Applicants reserve the right to present any withdrawn or cancelled subject matter in one or more continuation or divisional applications.

The Examiner has noted that several copies of documents marked with an asterisk were not available. Although Applicants previously forwarded these references, they will be resubmitted under separate cover to ensure that the Examiner has an opportunity to review them.

Applicants are pleased to note that the Examiner found claim 4 and all claims depending from claim 4 allowable. The Examiner has rejected pending claims 1, 3, 5, 10, 12-16, 18-22 and 29-71 under 35 U.S.C. § 112, first paragraph as allegedly lacking enablement for the scope of the method claim 1.

Applicants note that the U.S. Patent Office has previously granted U.S. Patent No. 6,610,835, of which the present application is a continuation, with claims to compounds including those in the method described in claim 1. The Examiner in both cases issued restriction requirements between the compounds and the method of using the compound to treat abnormal cell proliferation, which is the basis for the utility of the compounds in the specification.

By issuing the parent case, the Patent Office has already found that the application is enabled for the compounds recited in the pending method claims. The Patent Office thus found that these compounds had sufficient utility to allow issuance of a patent. It is the property of these compounds *as inhibitors of abnormal cell proliferation* that give them their utility. See *In re Pleuddemann*, 910 F.2d 823, 827 (C.A.Fed., 1990) (It is the properties of appellant's compounds as bonding/priming agents ... that give them their utility). See also *In re Papesch*, 315 F.2d 381, 391 (Fed. Cir., 1963) ("from the standpoint of patent law, a compound and all of its properties are inseparable"). In the Office Action of December 2, 2004, the Examiner has also admitted that the application provides sufficient enablement for compounds within the scope of the genus described in claim 1.

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The Patent Office has therefore acknowledged that there is sufficient utility in the specification to grant the compounds, and the only utility described in the specification is for the treatment of abnormal cell proliferation.

Applicants also point to pages 93-113 which provide the synthesis of a number of sphingolipid compounds that are in the scope of the compounds recited in the methods of the pending claims and pages 113-114 and figures 12-14, which show the biological activity of several of these compounds for the treatment of an abnormal cell proliferative disorder. The application also provides pages 115-119 describing pharmaceutical compositions and pages 77-83 on methods of treatment of abnormal proliferation. The extensive description in the application of the use of the compounds for the claimed methods ensures that it would not take any extraordinary experimentation for a skilled artisan to use any of the compounds in the claimed methods.

Applicants do not believe any additional fees are due with this response, however, the Commissioner for Patents is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 11-0980.

Respectfully submitted,

  
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